72-951 FILE COPY

FILED
JAN 2 1973
MICHAEL RODAK, JR., CLERK

In the Supreme Court of the United States

OCTOBER TERM, 1972

No. 72-951

SALEM EQUIPMENT, INC., and
EARL R. HITCHMAN,

Petitioners,

v.

KOCKUM INDUSTRIES, INC.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

J. PIERRE KOLISCH
JON M. DICKINSON
Attorneys for Petitioners

KOLISCH, HARTWELL
& DICKINSON
1004 Standard Plaza
Portland, Oregon 97204
Of Counsel

STEVENS-NESS LAW PUB. CO., PORTLAND, ORE. 12-72

TABLE OF CONTENTS

Page

Opinions Below 1

Jurisdiction 2

Question Presented 2

Statutory Provision Involved 2

Statement of the Case 3

Reasons for Granting the Writ 4

(1) The decision below conflicts with decisions of this Court 4

(2) The decision below conflicts with decisions of other circuits 6

(3) The decision below will create serious problems in the administering of § 112 7

(4) An answer at this time to the question presented herein is critical to the continued conduct of this case 8

Conclusion 9

Appendix A-1

TABLE OF AUTHORITIES

Page

Cases

Davies-Young Soap Co. v. *Nu-Pro Manufacturing Co.*, 273 F.2d 454 (1959) 6

General Electric Co. v. *Wabash Appliance Corp.*, 304 U.S. 364 (1938) 4, 5, 6, 7

Johnson & Johnson v. *Kendall Company*, 327 F.2d 391 (1964) 6

Norton Company v. *Bendix Corporation*, 449 F.2d 553 (1971) 6

United Carbon Co. v. *Binney & Smith Co.*, 317 U.S. 228 (1942) 5, 6, 7, 8

Statutes

28 U.S.C. § 1254 (1) 2

35 U.S.C. § 33 ..... 5, 8

35 U.S.C. § 112 ..... 2, 4, 5, 6, 7, 8

Consolidated Patent Act of 1870, c. 230, § 26, 16 Stat. 201 7

In the Supreme Court
of the United States

OCTOBER TERM, 1972

No.....

SALEM EQUIPMENT, INC., and
EARL R. HITCHMAN,

Petitioners,

v.

KOCKUM INDUSTRIES, INC.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

OPINIONS BELOW

The opinion of the Ninth Circuit, reported only at 175 U.S.P.Q. 81 (1972), appears in the appendix hereto. The District Court for the District of Oregon prepared no formal opinion, but did enter a judgment, and original and supplemental findings of fact and conclusions of law, which also appear in the appendix.

JURISDICTION

The judgment of the Ninth Circuit sought to be reviewed was entered on August 14, 1972. A timely petition for rehearing was filed on August 25, 1972, and was denied on October 6, 1972. Jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

QUESTION PRESENTED

Whether a combination-type patent claim may be held valid where it uses functional language at the exact point of alleged novelty.

STATUTORY PROVISION INVOLVED

35 U.S.C. § 112 provides:

"Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. A claim may be written in independent or dependent form, and if in dependent form, it shall be construed to in-

clude all the limitations of the claim incorporated by reference into the dependent claim.

"An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

STATEMENT OF THE CASE

Respondent filed a complaint on December 8, 1967 charging petitioners with infringement of United States Letters Patents Nos. 2,775,274 and 2,855,010. Petitioners answered — denying infringement, and counterclaiming for declarations of non-infringement, invalidity and nonenforceability. Among the grounds urged for invalidity was that the claims of both patents were indefinite for failure particularly to point out and distinctly to claim the alleged patentable subject matter.

After trial, the District Court issued findings of fact and conclusions of law (App. A-7) holding both patents invalid, and entered a judgment to such effect (App. A-17). Subsequently, the District Court issued supplemental findings of fact and conclusions of law (App. A-19) holding that petitioners had infringed certain claims of the patents, but declined to enter an order to that effect.

Respondent appealed from the judgment of inval-

idity, and petitioners cross-appealed from that judgment's failure to adjudicate that the claims of the patents were not infringed.

On August 14, 1972, the Ninth Circuit entered its opinion and judgment (App. A-1) vacating the District Court's judgment, and remanding the case for new trial on the issues of obviousness and infringement. In its opinion, the Ninth Circuit held that while the claims in the patents are indeed functional at the exact point of novelty, and thus do not meet the clarity requirements expressed in *General Electric Co.* v. *Wabash Appliance Corp.*, 304 U.S. 364 (1938), this deficiency may nonetheless be overcome by applying the provisions of the third paragraph of 35 U.S.C. § 112.

On August 25, 1972 petitioners filed a request for rehearing, which request was denied on October 6, 1972. Urged in that request as a ground for rehearing was that the second paragraph of § 112, whose predecessor language *Wabash* had applied, was controlling, and that the later-added third paragraph of § 112 did not change the applicability of the second paragraph of § 112.

REASONS FOR GRANTING THE WRIT

(1) The decision below conflicts with decisions of this Court.

In *Wabash*, in applying statutory language which is nearly a verbatim predecessor of that now contained in the first sentence of the second paragraph

of § 112, this Court held invalid on its face for indefiniteness a claim (on an electric lamp filament) using "functional language at the exact point of novelty" (304 U.S. at 371). The statute involved was former 35 U.S.C. § 33, whose pertinent language was:

> ". . . [the patent applicant] shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery." (Bracketed portion added)

Further speaking to this language, the Court said (304 U.S. at 369):

> "Patents, whether basic or for improvements, must comply accurately and precisely with the statutory requirement as to claims of invention or discovery. The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights. The inventor must 'inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.' "

In accord with *Wabash* is *United Carbon Co.* v. *Binney & Smith Co.*, 317 U.S. 228 (1942), where the Court, again applying the above-quoted language of former 35 U.S.C. § 33, and citing *Wabash*, held claims on a carbon black product to be invalid for indefiniteness.

The decision by the Ninth Circuit in the present case, which asserts that a claim though functional at the exact point of novelty may nevertheless be held valid, is in direct conflict with *Wabash* and *United Carbon*.

(2) The decision below conflicts with decisions of other circuits.

Contrary to the position taken below by the Ninth Circuit, the Second, Seventh, and Eighth Circuits all recognize the continuing vitality of the pronouncements quoted above from *Wabash*.

In *Norton Company* v. *Bendix Corporation*, 449 F.2d 553 (1971), the Second Circuit, relying both on § 112 and *Wabash*, held invalid for indefiniteness combination claims similar to those involved in the present case.

In *Johnson & Johnson* v. *Kendall Company*, 327 F.2d 391, 396 (1964) combination claims on a bandage were held invalid, with the Seventh Circuit, recognizing *Wabash*, saying:

> "It is well established that claim elements may not be functional at the point of alleged novelty."

Davies-Young Soap Co. v. *Nu-Pro Manufacturing Co.*, 273 F.2d 454 (1959), decided by the Eighth Circuit, concerned a combination claim for a dry cleaning method. Citing both § 112 and *Wabash*, the circuit court affirmed the trial court's adjudication that the claim was invalid for indefiniteness.

In contrast to what the Ninth Circuit decided here,

BLEED THROUGH POOR COPY

in none of these three cases did the particular circuit court find any basis for holding that a claim, although functional at the exact point of alleged novelty, could nevertheless be held valid under the provisions of the third paragraph of § 112.

(3) The decision below will create serious problems in the administering of § 112.

In order for the public to know the metes and bounds of an invention, for more than one hundred years each claim of a patent has been required to point out with particularity and to claim distinctively the subject matter of an alleged invention. That a valid claim must do this has been expressed continuously in the patent laws of this country ever since the Consolidated Patent Act of 1870, c. 230, § 26, 16 Stat. 201. The pertinent language in that act is identical to that quoted above which was considered in *Wabash*. This language has remained unchanged until July 19, 1952, when it was carried in somewhat rewritten form into what is now the first sentence in paragraph two of present § 112.

Just as this predecessor language, as interpreted by this Court in *Wabash* and *United Carbon*, requires unquestioned clarity at the point of alleged novelty in a claim, so also, we believe, does the present descendant language in paragraph two of § 112.

The decision of the Ninth Circuit eliminates the requirement of the second paragraph of § 112 with respect to combination-type claims, by holding that the third paragraph may be used to save such a claim

otherwise indefinite at the precise point of novelty. The decision thus raises an important issue as to the correct way to apply § 112 to combination-type claims —an issue which, if not resolved by this Court, will present a formidable hurdle to the future administering of § 112.

(4) An answer at this time to the question presented herein is critical to the continued conduct of this case.

The decision below remands this case for new trial on the issues of obviousness and infringement. For both of these issues, proper resolution depends upon a clear preunderstanding of the scopes of the claims. As this Court pointed out in *United Carbon*, referring to a resolution of the issues of anticipation and infringement, (317 U.S. at 232):

> "The scope and sufficiency of the claims in suit necessarily present themselves as preliminary problems in the resolution of these ultimate issues. The courts in determining the questions of invention and infringement brought to them by respondent, no less than the parties-litigant, need and may insist upon the precision enjoined by the statute."

The statute referred to here was former 35 U.S.C. § 33, and particularly that portion of the statute previously quoted.

The erroneous view of the Ninth Circuit, with respect to the relative roles of the second and third paragraphs of § 112, makes it impossible to obtain the necessary preunderstanding of the claims required for the new trial.

CONCLUSION

For the several reasons set forth above, a writ of certiorari should issue to review the question presented arising from the judgment and opinion of the Ninth Circuit.

Respectfully submitted,

J. PIERRE KOLISCH
JON M. DICKINSON
Attorneys for Petitioner

KOLISCH, HARTWELL & DICKINSON
Of Counsel

APPENDIX

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

Kockum Industries, Inc.,

Plaintiff-Appellant,

v.

Salem Equipment, Inc., and
Earl R. Hitchman,

Defendants-Appellees.

Kockum Industries, Inc.,

Plaintiff-Cross-Appellee,

v.

Salem Equipment, Inc., and
Earl R. Hitchman,

Defendants-Cross-Appellants.

Nos. 25,870, 25,874
[August 14, 1972]

Appeal from the United States District Court
for the District of Oregon

Before: MERRILL and BROWNING, Circuit Judges
and ZIRPOLI, District Judge*

MERRILL, Circuit Judge:

Appellant brought suit charging infringement of claim 12 of Andersson patent 2,775,274, and claims 1,

* Honorable Alfonso J. Zirpoli, United States District Judge for the Northern District of California, sitting by designation.

2, 3 and 5 of Leffler patent 2,855,010. The District Court dismissed the action, holding those patents invalid as to the claims in issue and this appeal followed.

The patents in suit relate to ring-type log debarkers in which the debarking tools are carried by a rotating ring through the center of which the logs are fed. The arms on which the tools are carred are biassed (sic) inwardly by springs or air pressure to maintain firm contact with the surface of the log and thus, on entry of the log, serve to obstruct its passage through the rotating ring. The tools and arms carrying them must for this reason be "opened" to accommodate the log. They could, of course, laboriously be opened (manually or by adjustment of inward pressure) for each new log. What the industry requires, however, is a self-opening mechanism. Many patents have sought to achieve this objective. The art, if not crowded, is certainly well occupied.

Self-opening has been achieved by relying on two mechanical responses based on ancient and well known principles: The camming or wedging and the screwing action.

In the case of camming action, the approaching log contacts the sloping plane of a wedge-shaped tool. The tool slides outward on its sloping edge as the log progresses until the tool reaches the periphery of the log and the debarking process commences.

The patent claims in issue purport to utilize screwing action. Here it is asserted the rotating tool fol-

BLEED THROUGH POOR COPY

lows grooves in the face of the log carrying the tool from a position at the center of the log face to its periphery. The tool of appellant's debarker presents a curved knife edge to the face of the log which, on contact, cuts a curved groove in the log's face from center to periphery, in which groove the tool, spurred by the rotation of its carrying ring, rides outward to the periphery of the log where debarking commences.

It is thus apparent that in the case of camming action the motivating force that brings the tool to the log's periphery is the forward motion of the log, while in the case of screwing action it is the rotation of the tools.

The District Court held that the claims in question had been anticipated by prior art. Our examination of the prior art in evidence convinces us that this was error. In all the prior patents introduced, camming action was utilized rather than screwing action. We conclude that on this record invalidity of the claims on the ground of anticipation is not established.[1]

A problem remains respecting the scope of the claims. It is the knife edge which is the heart of the self-opening mechanism in issue and on which appellant relies as imparting novelty. However, at this critical point of novelty the claims of the patents

[1] "Anticipation is strictly a technical defense. Unless all of the same elements are found in exactly the same situation and united in the same way to perform the identical function in a prior pleaded patent, there is no anticipation." *Stauffer* v. *Slenderella Systems of California*, 254 F.2d 127, 128 (9th Cir. 1957); *National Lead Company* v. *Western Lead Products Company*, 324 F.2d 539, 544 (9th Cir. 1963).

revert to descriptions in terms of function.[2] The claims of both patents recognize that a reaction known to the laws of mechanics can be initiated by a knife-edge penetration of the oncoming log face, which reaction will serve to carry the tool to the log's periphery. However, the sharp edge is not described (as to configuration or type of groove imparted or point of contact—whether at the center of the log face or its periphery) save in terms of the reaction it is to trigger, and thus in terms of what it is to accomplish.

The claims accordingly do not meet the requirements of *Gen. Electric Co.* v. *Wabash Co.*, 304 U.S. 364, 369 (1938).

Since that decision 35 U.S.C. § 112, dealing with the specifications contained in a patent application, has been amended to allow language in the specifications to limit and accordingly cure a claim stated in functional terms. It provides:

> "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such

---

[2] Andersson Claim 12: "having at least one relatively sharp edge integral therewith and facing the direction of log feed for engaging the face of the butt end of an oncoming log to automatically lift the debarking portion of the tool up onto the peripheral surface of an oncoming log by a screwing action on such face as the frame rotates."

Leffler Claim 1: "Said log—impactible edge being provided with a sharp edge to penetrate such fore end of an impacting log for the purpose of causing the scraping member * * * to be swung on its pivot axis in such a manner that the free end of the scraping member will climb onto a peripheral surface of an impacting log."

BLEED THROUGH POOR COPY

claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

In both patents the specifications contain limiting language bearing on the nature of the knife edge.[3]

[3] In Andersson we find the following:

"The face of the tool body that is directed toward the oncoming log is provided with saw-tooth ridges or projections 66. These projections are at an angle relative to the axis of the piston rod and they operate to lift the tool when a log being debarked is followed by a log of larger diameter. The tool will ride up onto the second log since these ridges will engage the face of the butt end of such second log and initiate a screw action when the tool is rotated around the log."

And, further:

"The tool body illustrated in Figures 4, 7 and 9 is provided with a lifting edge 120A which extends between the points 118 and 120. This edge is relatively sharp and projects outwardly from the surface of the face 110D as shown in Figures 8 and 9 and as illustrated by the dotted lines between points 138 and 136 in Figure 4."

Likewise in Leffler the specifications provide "* * * said edge should be sharp and may be shaped as a knife according to Figure 6 or, more preferably as inclining knive 15' according to Figure 7. The outward extent of the log-impactible knife edge is determined by the diameter of the thickest log and the knife-edge should extend a short distance along a bow-shaped or curved portion 17 of the scraping member, as shown in Fig. 4. When said log-impactible edge at the curved portion 17 of the scraping member penetrates the peripheral corner of the butt end of the log, the angular speed of the outwardly-swinging scraping member will be increasing owing to the shown radius of said bow-shaped or curved portion 17 and the scraping edge 16 of the scraping member will be thrown onto the surface of the log. If a log-contacting edge 18 of the curved portion 17 of the scraping member slides into contact with the log, the scraping member is not swung outwardly in the same manner nor for the same reasons as when the portion 14 is impacted by the log. In order that axial movement of the log will not be arrested by its contact with said log-contacting edge 18,

Construing the claims in question as so limited by the specifications invalidity under *Gen. Electric Co.* v. *Wabash Co., supra,* is avoided.

As an alternative to its ruling on anticipation the District Court held that the claims were obvious in the light of prior art. Since our ruling results in a restating of the claims and provides a new focus for consideration of the issues of obviousness and, if need be, of infringement, a remand is necessary in order that those issues can be re-examined in this new context.

The judgment of the District Court is vacated and the matter is remanded for limited new trial.

---

the latter is sloped forwardly from the knife-edge 15 or toward the trailing edge of the scrapers, so that the angle it makes with a line parallel to the axis of rotation of the drum is less than that of the log-impactible edge 15, which as already mentioned is less than 90°. Hereby an advantageous wedge angle is obtained and the bowed portion 17 is wedged up, so that the scraping edge 16 will move onto the surface of the log, the log-contacting edge 18 and the log sliding relatively to each other; for which reason said edge 18 should be rounded in cross section as shown in Figure 8 or be formed with a clearing angle as shown in a modified log-contacting edge 18' in Fig. 9."

BLEED THROUGH, POOR COPY

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF OREGON

KOCKUM INDUSTRIES, INC.,

Plaintiff

v.

SALEM EQUIPMENT, INC. and
EARL R. HITCHMAN,

Defendants.

Civil No. 67-642

FINDINGS OF FACT AND CONCLUSIONS OF LAW

This cause came on for trial on the 30th day of June and the 1st day of July, 1969, before the court sitting without a jury. The court being fully advised makes the following:

FINDINGS OF FACT

1. Plaintiff, Kockum Industries, Inc., is a corporation of the State of Alabama, having its principal place of business in Talladega, Alabama and having a regular and established place of business in Tualatin, Oregon, at which it manufactures and sells ring-type log debarkers.

2. Defendant, Salem Equipment, Inc. (Salem) is a corporation of the State of Oregon having its principal place of business in Salem, Oregon, where it manufactures and sells "Salem" or "Salem-Brunette" ring-type log debarkers of which complaint is made in the present suit.

3. Defendant Earl R. Hitchman is a resident of Salem, Oregon, and is President of Salem Equipment, Inc. He and his wife presently own 100% of the capital stock in such corporation. He is actively engaged in the management and everyday affairs of the corporation.

4. Plaintiff was at the time of filing of the compalint and is now the owner of United States Letters Patent Nos. 2,775,274 (Andersson) and 2,855,010 (Leffler). Plaintiff acquired title to the Andersson patent by assignment from Soderhamns Verkstader Aktiebolaget, a corporation of Sweden, and acquired title to the Leffler patent by assignment from Svenska Cellulosa Aktiebolaget, a corporation of Sweden.

5. Brunette Machine Works Ltd. (Brunette) is a corporation of British Columbia, Canada, having its principal place of business in New Westminster, B. C., at which place it manufactures and sells "Brunette" ring-type log debarkers.

6. The specific accused equipment is a debarking tool used in a ring-type log debarker. Salem got into the business of manufacturing and selling this type of equipment as a result of entering into a license agreement with Brunette in November, 1963. Brunette furnished Salem with all the information used in manufacturing the "Salem", "Salem-Brunette" equipment which is substantially the same as the "Brunette" equipment.

7. All prior art that shows any type of debarking machine with self-opening tools is pertinent because

plaintiff has taken the position that any debarking machine that has self-opening tools may be covered by the claims of the Andersson and Leffler patents.

8. Andersson patent 2,775,274 is for an improvement in a self-opening debarking tool for a ring-type log debarker, and as stated in the specifications of the patent:

> "More specifically this invention has for an object to provide a tool which has a surface or surfaces thereon facing the oncoming logs, which in consequence of the rotation of the hollow head effects an automatic adjustment of the position of the tool relative to the axis of the log being fed when a succeeding log is of larger diameter than a preceding log, or in instances where the hollow head has been rotated with the tools in their inner position and no log in the machine, and which surface or surfaces comprises at least one sharp edge that engages the face of the butt end of such a succeeding log or of the first log fed to the head to automatically lift the debarking portion of the tool up and onto the surface of the log by a screwing action on such face as the head rotates."

9. Plaintiff charged defendants with infringement of only claim 12 of Andersson, and defendants' counterclaimed for a declaration that the patent is invalid.

10. Claim 12 of Andersson may be treated as typical of the claims in that patent, and it reads as follows:

> "In a machine for debarking logs, comprising

in combination a rotatable annular frame through which a log is axially fed, a plurality of debarking tools carried by said frame and means mounting the tools for movement toward and away from the axis of rotation of the frame, each tool including a bark-penetrating and debarking portion constituted by a blunt edge adapted to make contact with a wood surface underlying such bark without damaging this surface, means for maintaining the tools and thereby the debarking portion in substantially continuous contact with such wood surface for removing bark by shearing force exerted substantially tangentially to a peripheral surface of a log being debarked, and the debarking portion of each tool having at least one relatively sharp edge integral therewith and facing the direction of log feed for engaging the face of the butt end of an oncoming log to automatically lift the debarking portion of the tool up onto the peripheral surface of an oncoming log by a screwing action on such face as the frame rotates."

11. Analysis of claim 12 of Andersson shows that the invention there claimed is for an improvement in self-opening tools for log debarking machines, the essential elements of which are as follows:

A. plurality of debarking tools

B. means mounting the tools for movement toward and away from the center of the machine

C. each tool including a blunt-edged debarking portion

D. means for maintaining the debarking portions of the tools in substantially continuous contact with a log

E. the debarking portion of each tool having at least one relatively sharp edge for engaging the face of the butt end of a log to lift the debarking edge onto the periphery of the log.

12. Andersson did not invent self-opening debarking tools. The prior art shows various types of such debarking tools. Some of these tools are shown in Olson patent No. 1,248,700, Kolpe et al patent 2,646,092, Italian patent to Burgo 436,638, Australian patent to Andersson 151,988.

13. Olson patent 1,248,700 discloses a self-opening debarking tool 25 which is pivotally mounted at 26a for movement toward and away from the center of the machine. A plurality of cutters 26 are mounted on tool 25 and are adapted to scrape bark from a log. The various parts of the tool are shown in an exploded view in Fig. 5 of the patent and described in the specification. The tool is maintained in continuous contact with a log by means of a leaf spring. The tool has a relatively sharp leading edge 28a which engages the incoming end of a log being fed into the machine.

14. Earlier Andersson disclosed and claimed a self-opening debarking tool very similar to the one that is the subject of his patent in suit. The earlier tool was the subject of Andersson Australian patent 151,988 which patent shows on its face that the complete specification was published on January 11, 1951. This publication date is both (a) more than one year prior to the actual filing dates in the United

States of Andersson's application Serial No. 273,212 (February 25, 1952) and Andersson's continuation-in-part application which matured into U.S. Patent 2,775,274 and (b) prior to the earliest date (Swedish prioity (sic) date of March 8, 1951, which appears on the face of the patent) to which the Andersson patent in suit is entitled. The Australian patent is prior art to Andersson patent 2,775,274.

15. Andersson Australian patent 151,988, particularly Fig. 3, shows a debarking tool which is almost identical with the tool shown in Fig. 4 of the Andersson patent in suit. Claim 12 of the patent in suit reads directly on Fig. 3 of the Australian patent. The close correspondence between Fig. 3 of the Australian patent and the Andersson patent is brought out in the specification of the Australian patent.

16. Neither the Olson patent nor the Australian patent were before the Patent Office when it approved the application which resulted in Andersson patent 2,775,274, and therefore, the presumption of validity attaching to that patent is overcome.

17. Kolpe et al 2,646,092, shows a log debarking machine of the ring type having a plurality of self-opening debarking tools 5 whose leading edges 6 are "chamfered." The tools are pivotally mounted and edges 6 are engaged by the oncoming end of a log causing the tools to be lifted to the periphery of the log and place the bark-abrading mechanism projecting from the end of the tool in contact with the bark.

18. The Italian Burgo patent 436,638 discloses a

debarking machine of the ring-type in which a plurality of self-opening debarking tools 17, 18, 19 are urged by springs 20 toward the center of drum 15. The butt end of an oncoming log engages the leading edge of a tool, forcing it to open until knife edge 17 of hook-shaped portion 18 at the end of the tool engages the bark on a log and starts peeling it off. While Burgo does not state the degree of sharpness of the leading edge of his debarking tool, his drawings and particularly Fig. 2 show the edge as being relatively thin or sharp. Furthermore, since Burgo's tool is of the self-opening type, its leading edge was made sufficiently sharp to cause self-opening.

19. The previously discussed Olson, Australian, Kolpe et al and Italian patents each discloses everything called for in claim 12 of Andersson patent 2,775,274. However, even if these patents do not anticipate Andersson they come so close to the subject matter of Andersson that whatever improvements he may have made were obvious to a person of ordinary skill in the art at the time Andersson made his alleged invention.

20. The commercial machines manufactured by plaintiff and Salem have debarking tools whose edges vary in degree of sharpness depending upon the manner in which the tools are used and the time of year.

21. There is nothing critical about the degree of sharpness of the leading and debarking edges of a debarking tool. It will operate with varying degrees of proficiency depending upon the conditions under which it is being used.

22. If Andersson made any improvement over the prior art it was in the particular configuration of his debarking tool. This was not a patentable invention. At best all he did was change the form or shape of an existing tool to obtain an improved result.

23. The elements called for in claim 12 of Andersson and listed in finding 11 above as A, B, C, D, E, are all old. Andersson's assembly of these elements produced no new, surprising or different result. Andersson merely followed the teachings of the prior art in that he positioned his tools on a rotating ring and urged them towards the center of the machine so that the incoming end of a log would engage the leading edge of a tool and lift it onto the periphery of the log to scrape away the bark as the tools were rotated about the log.

24. The Leffler patent 2,855,010 is for an improvement in self-opening debarking tools for a ring-type debarker.

25. Plaintiff charged defendants with infringement of claims 1, 2, 3 and 5 of Leffler, and defendants counterclaimed for a declaration that the patent is invalid.

26. Claim 1 of Leffler may be treated as typical of the claims in the patent and it reads as follows:

> "An improvement in barking machines of the kind having at least one scraping member mounted in a drum and movable into and out of engagement with a log, said machines having at least one of the two elements, the scraping member and a log, adapted to rotate relatively to the other

about the axis of the drum, said improvement comprising a scraping member having a bark-scraping edge at its free end, pivot means for mounting its opposite end on the drum so that the scraping member will swing on an axis which is substantially parallel with the axis of the drum, said scraping member being provided with a log-impactible edge adapted to be hit by a fore end of an oncoming log fed into the machine and to form an angle of less than 90° with a line parallel to the axis of the drum, said log-impactible edge being provided with a sharp edge to penetrate such fore end of an impacting log for the purpose of causing the scraping member, during its relative rotation with respect to an impacting log, to be swung on its pivot axis in such a manner that the free end of the scraping member will climb onto a peripheral surface of an impacting log."

27. Analysis of claim 1 of Leffler shows that the invention there claimed is for an improvement in self-opening tools for log debarking machines, the essential elements of which are as follows:

A. A tool having a bark scraping edge at one end

B. A pivot mounting at the other end of the tool

C. A sharp edge on the tool for engaging the fore end of a log to lift the scraping edge of the tool onto the periphery of the log.

28. The prior art patents of Olson, Italian Burgo, and Kolpe et al each have elements A, B, C of the Leffler patent, operating in the same manner as Leffler. Even if these prior art patents do not anticipate

Leffler they come so close to the subject matter of Leffler that whatever improvements he may have made were obvious to a person of ordinary skill in the art at the time Leffler made his alleged invention.

29. Claim 2 of Leffler patent adds to claim 1 the limitation that the tool has a bow shaped portion; claim 3 specifies that the leading edge of the tool is wedgeshaped and claim 5 states that the tool is curved. All these claims are dependent from claim 1 and since it is invalid they must also fall. The limitations added by these claims are minor design changes involving no new principles and the claims are invalid.

30. All of the elements called for in the Leffler claims are old. Their assembly produced no new, different, or surprising result from that which would have been expected from the bringing together of these old elements.

Based upon the foregoing Findings of Fact, the court hereby makes the following:

CONCLUSIONS OF LAW

1. This court has jurisdiction of the subject matter and of the parties.

2. Andersson patent 2,775,274 is invalid.

3. Leffler patent 2,885,010 is invalid.

4. The complaint is dismissed and defendants are entitled to taxable costs.

Dated this 14th day of January, 1970.

/s/ *Robert C. Belloni*
United States District Judge

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF OREGON

KOCKUM INDUSTRIES, INC.,

Plaintiff,

v.

SALEM EQUIPMENT, INC., and
EARL R. HITCHMAN,

Defendants.

Civil No. 67-642

JUDGMENT

This cause came on for trial before the Court sitting without a jury, and the Court being fully advised and having made its findings of fact and conclusions of law dated January 14, 1970,

IT IS HEREBY ORDERED that

1. United States Letters Patent 2,775,274 is invalid;

2. United States Letters Patent 2,855,010 is invalid; and

3. The complaint is dismissed and defendants are awarded taxable costs.

Dated this 15th day of January, 1970.

/s/ *Robert C. Belloni*
United States District Judge

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF OREGON

KOCKUM INDUSTRIES, INC.,

Plaintiff,

v.

SALEM EQUIPMENT, INC. and
EARL R. HITCHMAN,

Defendants.

Civil No. 67-642

SUPPLEMENTAL FINDINGS OF FACT AND CONCLUSIONS OF LAW

Findings of Fact and Conclusions of Law in the above matter were entered on the 14th day of January, 1970. The plaintiff has requested, and the defendant has consented, that the court make findings with respect to the issue of infringement. While the holding of invalidity of Andersson patent No. 2,775,-274 and Leffler patent No. 2,855,010 renders a finding on infringement unnecessary, nevertheless the court makes the following:

SUPPLEMENTAL FINDINGS OF FACT

1. The pivoted self-opening tool arms on the various sizes of accused Salem-Brunette ring debarkers are all of substantially the same design. The leading edge of these tool arms has an inclination to the vertical plane to provide for advance of the log while the tools are opening, is bowed lengthwise, beveled at 45

degrees, treated with hard surfacing material and is sharp. The debarking edge of the accused Salem-Brunette tool arms is blunt. The Leffler claims in suit make no specification as to the configuration of the debarking edge except to define it as "bark-scraping edge" which the Salem-Brunette tools do possess at their free end.

2. The leading edge on the accused tool arms is sharp. When it engages the butt end of a log it leaves permanent indentations therein. The bark scraping edge is of different degrees of roundness in accordance with the nature and type of wood being debarked and the seasonal conditions. However, it is not as sharp as the leading edge and is blunt as compared to that edge. Claim 12 of Andersson calls for a sharp edge for engaging the face of the butt end of a log and a blunt edged debarking portion. Claim 1 of Leffler calls for a sharp edge on the tool for engaging the fore end of a log to lift the scraping edge of the tool onto the periphery of the log.

3. Claim 2 of Leffler adds to claim 1 the limitation that the tool has a bow-shaped portion. Claim 5 states that the tool is curved. The tools on the accused equipment are bow-shaped.

4. Claim 3 of Leffler calls for a long-impactible edge that is wedge-shaped. This edge on the accused equipment is made by two surfaces intersecting at a 45° angle, and is wedge-shaped.

Based on the foregoing the court makes the following:

SUPPLEMENTAL CONCLUSIONS OF LAW

1. Defendants have infringed claim 12 of Andersson patent No. 2,775,274 and claims 1, 2, 3 and 5 of Leffler patent No. 2,855,010.

Dated this 21st day of January, 1970.

/s/ *Robert C. Belloni*
United States District Judge

IN THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

KOCKUM INDUSTRIES, INC., Plaintiff-Appellant, vs. SALEM EQUIPMENT INC., and EARL R. HITCHMAN, Defendants-Appellees.	No. 25,870
KOCKUM INDUSTRIES, INC., Plaintiff-Cross-Appellee, vs. SALEM EQUIPMENT, INC., and EARL R. HITCHMAN, Defendants-Cross-Appellants.	No. 25,874

ORDER

Before: MERRILL and BROWNING, Circuit Judges, and ZIRPOLI, District Judge

Rehearing is denied.

The motion of Kockum Industries, Inc., for clarification of our remand for limited new trial is denied. In our view the extent to which new evidence is to be allowed should be left to the discretion of the District Court upon its appraisal of the sufficiency of the present record to reach the remand issues.

FILED
Oct. 6, 1972

DENNIS R. MATHEWS, Clerk
U. S. Court of Appeals

FILE COPY

FILED
MAR 26 1973
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1972

No. 72-951

SALEM EQUIPMENT, INC., and
EARL R. HITCHMAN,
Petitioners,

v.

KOCKUM INDUSTRIES, INC.,
Respondent.

BRIEF IN ANSWER TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

RICHARD W. SEED
Attorney for Respondent

Of Counsel:
SEED, BERRY, DOWREY & CROSS
1502 Norton Building
Seattle, Washington 98104

CRAFTSMAN & MET PRESS — SEATTLE, WASHINGTON

SUBJECT INDEX

Page

Argument in Answer to Petitioner 1

Conclusion 9

TABLES OF AUTHORITY

Table of Cases

Application of Fuetterer, 319 F.2d 259 (C.C.P.A. 1963) 6

Application of Swinehart, 439 F.2d 210 (C.C.P.A. 1971) 2, 4, 6

Arnold Pipe Rentals Co. v. Engineering Enterprises, Inc. 350 F.2d 885 (5th Cir. 1965) 3

Carnegie Steel Co. v. Cambria Iron Co., 185 U.S. 403 (1902) 3

Chicago Pneumatic Tool Co. v. Hughes Tool Co., 97 F.2d 945 (10th Cir. 1938) 3-4

Cold Metal Process Co. v. Republic Steel Corp., 123 F. Supp. 525 (D.C.N.D. Ohio) *aff'd* 233 F.2d 828 (6th Cir. 1956) *cert. den.* 352 & S. 955 3

Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U.S. 405 (1907) 3

Davies-Young Soap Co. v. Nu-Pro Manufacturing Co., 273 F.2d 454 (8th Cir. 1959) 5

Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U.S. 45 (1923) 3, 8

Faulkner v. Gibbs, 338 U.S. 267 (1949) 1

General Electric Co. v. Wabash Appliance Corp., 304 U.S. 364 (1938) 2, 3, 5, 6, 7, 8

Georgia-Pacific Corp. v. United States Plywood Corp., 258 F.2d 124 (2d Cir. 1958) *cert. den.* 358 U.S. 884 3

Halliburton Oil Well Cementing Co. v. Walker, 329 U.S. 1 (1946) 6

Page

H. H. Robertson Co. v. Klauer Mfg. Co., 98 F.2d 150 (8th Cir. 1938) 3

Ingersoll Milling Machine Co. v. General Motors Corp., 207 F.2d 42 (7th Cir. 1953) 3

Ives v. Hamilton, 92 U.S. 426, 23 L. Ed. 494 (1876) 3

Johnson & Johnson v. Kendall Company, 327 F.2d 391 (7th Cir. 1964) 5

Jones Knitting Corp. v. Morgan, 361 F.2d 451 (3d Cir. 1966) 3

Lever Bros. v. Proctor & Gamble Mfg. Co., 139 F.2d 633 (4th Cir. 1943) 3

Locklin v. Switzer Brothers, Inc., 299 F.2d 160 (9th Cir. 1961) *cert. den.* 369 U.S. 861 ..... 3, 7-8

Minerals Separation v. Hyde, 242 U.S. 261 (1916) 3

Mowrey v. Whitney, 14 Wall. 620, 20 L. Ed. 860 (1871) 3

Statutes

35 U.S.C.A. Vol. 1, p. 25 (1954) 6

IN THE

Supreme Court of the United States

OCTOBER TERM, 1972

No. 72-951

SALEM EQUIPMENT, INC., and
EARL R. HITCHMAN,
Petitioners,
v.
KOCKUM INDUSTRIES, INC.,
Respondent.

BRIEF IN ANSWER TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

ARGUMENT IN ANSWER TO PETITIONER

The question presented by petitioner, "whether a combination-type patent claim may be held valid where it uses functional language at the exact point of alleged novelty," erroneously implies that prior to the Ninth Circuit decision in the present case that question had been uniformly answered in the negative by this Court and by the Second, Seventh and Eighth Circuits, and also erroneously implies that the patent claims here in issue only use functional language at a so-called point of novelty.[1]

1. *Faulkner v. Gibbs*, 338 U.S. 267, 268 (1949). It is doubtful that a combination claim, as distinguished from a "single means" claim or a claim for composition of matter, can properly be considered as having an "exact point of novelty."

The Court below stated that "[i]t is the knife edge which is the heart of the self-opening mechanism in issue and on which appellant relies as imparting novelty." This sharp edge on the tool arms facing toward the oncoming log is specifically recited as an element of the combination in each of the claims in issue. The claims do not attempt to patentably distinguish from the prior art merely by functional statements, but clearly teach those skilled in the art how to utilize a screwing action to self-open the tool arms rather than the camming action which the Ninth Circuit found to have been used in all of the prior art in evidence. It was for this reason that the Ninth Circuit vacated the judgment of the District Court.

In *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364 (1938), this Court was not presented with a combination claim but a product claim for a filament for electric incandescent lamps "composed substantially of tungsten and made up mainly of a number of comparatively large grains of such a size and contour as to prevent substantial sagging and offsetting during a normal or commercially useful life for such a lamp or other device." The decision recognized (P. 371-372) that "[a] limited use of terms of effect or result, which accurately define the essential qualities of a product to one skilled in the art, may in some instances be permissible or even desirable," but this Court then pointed out that "a characteristic essential to novelty may not be distinguished from the old art *solely* by its tendency to remedy the problems in the art met by the patent."

The Court of Customs and Patent Appeals has extensively discussed "functional" claims in *Application of Swinehart*, 439 F.2d 210, 212-213 (C.C.P.A. 1971) and

BLEED THROUGH POOR COPY

prior decisions cited therein, and cited the *Wabash* case for an example of claim language so broad that it causes the claim to have a potential scope of protection beyond that which is justified by the specification disclosure. The Court then pointed out that "[t]his ground of rejection is now recognized as stemming from the requirements of the first paragraph of 35 U.S.C. §112."

As previously indicated, the claims here in issue are not worded merely in terms of result to be achieved, but teach a person skilled in the art how to reach that result, and hence are not improperly functional or indefinite. *Mowrey v. Whitney,* 14 Wall. 620, 20 L. Ed. 860, 864 (1872); *Ives v. Hamilton,* 92 U.S. 426, 23 L. Ed. 494, 496, (1876); *Carnegie Steel Co. v. Cambria Iron Co.,* 185 U.S. 403, 437 (1902); *Continental Paper Bag Co. v. Eastern Paper Bag Co.,* 210 U.S. 405, 422 (1907); *Minerals Separation v. Hyde,* 242 U.S. 261, 271 (1916); *Eibel Process Co. v. Minnesota & Ontario Paper Co.,* 261 U.S. 45, 65-66 (1923). *Georgia-Pacific Corp. v. United States Plywood Corp.,* 258 F.2d 124, 138 (2 Cir. 1958), cert. den. 358 U.S. 884; *Jones Knitting Corp. v. Morgan,* 361 F.2d 451, 454 (3 Cir. 1966); *Lever Bros. v. Proctor & Gamble Mfg. Co.,* 139 F.2d 633, 639-640 (4 Cir. 1943); *Arnold Pipe Rentals Co. v. Engineering Enterprises, Inc.,* 350 F.2d 885, 892 (5 Cir. 1965); *Cold Metal Process Co. v. Republic Steel Corp.,* 123 F. Supp. 525, 539 (D.C.N.D. Ohio), aff'd 233 F.2d 828, 840 (6 Cir. 1956), cert. den. 352 U.S. 955). *Ingersoll Milling Machine Co. v. General Motors Corp.,* 207 F.2d 42, 45 (7 Cir. 1953); *H. H. Robertson Co. v. Klauer Mfg. Co.,* 98 F.2d 150, 153 (8 Cir. 1938); *Locklin v. Switzer Brothers, Inc.,* 299 F.2d 160, 166 (9 Cir. 1961), cert. den. 369 U.S. 861; *Chicago Pneumatic Tool Co. v. Hughes*

Tool Co., 97 F.2d 945, 947 (10 Cir. 1938); *Application of Swinehart*, 439 F.2d 210, 212-213 (C.C.P.A. 1971).

None of the three Circuit Court cases cited by petitioner for the proposition that the decision below conflicts with decisions of other circuits, involve a combination-type patent claim which was held invalid because it allegedly used functional language at the exact point of novelty.

In *Norton Company v. Bendix Corporation*, 449 F.2d 553, 555 (2 Cir. 1971) the Second Circuit correctly pointed out that "Section 112 evinces two objectives: first, that in return for the grant of a patent monopoly the patentee must make sufficient disclosure to enable one skilled in the art to reconstruct the invention; and second, that the patentee describe his invention with sufficient definiteness to enable others to discern the boundaries beyond which experimentation and invention are undertaken at the risk of infringement." The Court then held that the contested claims fell short of meeting the second of these objectives because the testimony of the plaintiff's expert witnesses defined the terms "closely spaced" and a "substantial distance", used in the claims, in a vague and even contradictory manner. Thus, the Court held that the claims were invalid because they were fatally indefinite, and not because they used functional language at the exact point of alleged novelty.

The evidence in the present case clearly proves that the degree of sharpness for the leading edge of the tool arm required to practice the inventions in suit is all within the ready understanding of one reasonably skilled in the art. This is clearly established by the testimony of Nelson (T. 30-31), Gaitten (T. 261-262) and licensee Nicholson (PX

58, p.49: 21-23) that "we, know what works and what doesn't work." For this reason neither the District Court or the Circuit Court held that the claims were indefinite, particularly in view of the descriptions in the patent specifications cited by the Circuit Court in their opinion.

In *Johnson & Johnson v. Kendall Company,* 327 F.2d 391 (7 Cir. 1964) the Court held a patent to an adhesive bandage with smooth facings invalid under Section 103 in view of the prior art, and did not rule that the claims were functional at the point of alleged novelty.

The Eighth Circuit in *Davies-Young Soap Co. v. Nu-Pro Manufacturing Co.,* 273 F.2d 454 (8 Cir. 1959) had under consideration a method claim for dry cleaning a fabric and simultaneously rendering it antistatic. To avoid prior art the patentee argued that the patent claim should be narrowed in light of the specification to add five additional elements not recited in the claim. The Court rejected this argument and cited the *Wabash* case, *supra,* for the analogous proposition that product claims may not be saved by a limitation to products produced in accordance with a process set out in the patent specification. This is not the situation in the present case.

If the *Wabash* case is a holding that prior to the 1952 Patent Act there was an extrastatutory case law prohibition applicable to the Andersson and Leffler claims in the present case, other than the prohibitions presently set forth in the first two paragraphs of Section 112, which was cast aside in 1952 by the adoption of the third paragraph in Section 112, then the Circuit Court decision below is correct in its statement respecting the *Wabash* case. This is very possible in view of the references to the *Wabash* case

in *Halliburton Oil Well Cementing Co. v. Walker,* 329 U.S. 1, 8, 9, 11 (1946), and the fact that most authorities agree that the third paragraph of Section 112 was specifically drafted to permit greater liberality in the use of functional expressions in combination claims. *Application of Fuetterer,* 319 F.2d 259, 264-265, footnote 11 (C.C.P.A. 1963); *Application of Swinehart,* 439 F.2d 210, 212-213 (C.C.P.A. 1971). P. J. Federico in his Commentary on the New Patent Act, 35 U.S.C.A., Vol. 1, p. 25 (1954), stated:

> "The last paragraph of section 112 relating to so-called functional claims is new. . . . It is unquestionable that some measure of greater liberality in the use of functional expressions in combination claims is authorized than had been permitted by some Court decisions, and that decisions such as that in Halliburton Oil Well Cementing Co. v. Walker, 67 S.Ct. 6, 329 U.S. 1, 91 L.Ed. 3 (1946) are modified or rendered obsolete, but exact limits of the enlargement remain to be determined."

However, respondent does not believe that the *Wabash* case was intended to recite extrastatutory case law, and so believes that the Court below erred in commenting that the claims do not meet certain requirements propounded in the *Wabash* decision. Respondent has reached this latter conclusion because the specification and claims in issue clearly meet all of the requirements of the first and second paragraphs of Section 112.

Whether or not the Ninth Circuit was correct in the present case respecting the applicability of the *Wabash* decision prior to 1952, it is clear that the decision below was *not* a holding that a claim does *not* have to meet the requirement of the second paragraph of Section 112 if it contains functional language authorized by the third paragraph thereof.

It is also evident that there is no longer any valid extra-statutory case law respecting functional or indefinite combination-type claims, whatever may have existed prior to the enactment of the third paragraph of Section 112. This has been the position of the Ninth Circuit at least as early as 1961 in *Locklin v. Switzer Brothers, Inc., supra*. In that case the appellant attacked the validity of Switzer's patent on the ground that the limits of melamine in the claimed resin of the patent were expressed in functional language. The patent claims provided that the amount of melamine shall be "an amount . . . sufficient to render said condensation product substantially insoluble in aromatic hydrocarbon solvents but insufficient to render it thermosetting." Since the novelty in the patented resin was that it is both thermoplastic and insoluble, the appellant contended that the above claim language violates a rule against the use of functional language at the precise point of novelty."

The Ninth Circuit rejected the appellant's argument in the *Locklin* case as follows at pp. 165-166 quoting extensively from the *Wabash* case:

> "In our case Switzer, in justification of the functional language, points out that the alternative would have been to state the critical lower limits precisely. This was done in the examples set forth in the specification. Switzer points to the fact that of the considerable number of melamine compounds encompassed by the patent, each has a different critical limit. It asserts that this renders it wholly unreasonable to expect the claims to be specific in this respect or to expect any further specificity than that which appear in the examples given.
>
> "In the General Electric case [Wabash case], the effect of the functional language was to broaden the claim to include all grains of whatever size or shape

so long as they would accomplish the desired result. In our case the critical area is not enlarged in such a fashion. The critical point remains the same for each melamine compound used. It simply is not specified. But whether specified or unspecified the scope of the claim is precisely that of the invention.

"Nor can it be said that this failure to specify the critical limit precisely results in a fatal vagueness of description. The claim must be sufficiently clear to allow others to reproduce the result at the end of the monopoly period and to enable contemporary inventors to ascertain whether or not they are infringing.

"Upon this point the district court concluded:

> " 'When the general description, the specific examples, and the claims are read together, the invention is so plainly defined that no one skilled in the art should have any difficulty in practicing it.'

"The record supports this statement. There is testimony to the effect that 'sufficient malamine to render the resin substantially insoluble' is a simple, clear test for an ordinary chemist to perform and one which does not require extensive experimentation in order that the precise critical limits be ascertained in a particular case. Under such circumstances, the fact that some preliminary testing is required does not render the claim invalid for vagueness. Mineral Separation, Limited v. Hyde, 1916, 242 U.S. 261, 37 S. Ct. 82, 61 L. Ed. 286."

In view of the foregoing detailed discussion in the *Locklin* case, and other portions of that decision, and like remarks by this Court in *Eibel Process Co. v. Minnesota & Ontario Paper Co. supra,* at 65, and the other Supreme Court and Circuit Court cases cited therewith earlier in this brief, even if the Ninth Circuit erred in the present case in stating that the claims in issue would not have met the requirements of the *Wabash* case, such will not create problems in the proper administering of Section 112 or in

obtaining that understanding of the claims in suit necessary for further proceedings in this case.

CONCLUSION

For several reasons set forth above, the decision below does not conflict with decisions of this Court or decisions of other Circuits, and will not create problems in the administering of Section 112 or in the further trial of this case. Accordingly, the petition for writ of certiorari to the United States Court of Appeals for the Ninth Circuit should be denied.

Respectfully submitted,

RICHARD W. SEED
Attorney for Respondent

Of Counsel:
SEED, BERRY, DOWREY & CROSS
RICHARD W. SEED
1502 Norton Building
Seattle, Washington 98104

FILE COPY

Supreme Court, U. S.
FILED
MAR 28 1973
MICHAEL RODAK, JR., CLERK

In the Supreme Court of the United States

OCTOBER TERM, 1972

No. 72-951

SALEM EQUIPMENT, INC., and
EARL R. HITCHMAN,

Petitioners,

v.

KOCKUM INDUSTRIES, INC.,

Respondent.

REPLY TO BRIEF IN ANSWER TO A PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

J. PIERRE KOLISCH
JON M. DICKINSON
Attorneys for Petitioners

KOLISCH, HARTWELL
& DICKINSON
1004 Standard Plaza
Portland, Oregon 97204
Of Counsel

STEVENS-NESS LAW PUB. CO., PORTLAND, ORE. 3-73

In the Supreme Court
of the United States

OCTOBER TERM, 1972

No. 72-951

SALEM EQUIPMENT, INC., and
EARL R. HITCHMAN,

Petitioners,

v.

KOCKUM INDUSTRIES, INC.,

Respondent.

REPLY TO BRIEF IN ANSWER TO A PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

Respondent's brief avoids coming to grips with the four reasons for granting the writ of certiorari set forth in the petition. The principal argument in the brief is one going to the merits of the case, i.e., that the claims of the two patents in suit, Andersson and Leffler, do not "patentably distinguish from the prior art merely by functional statements" (Resp. Br., p. 2).

Respondent's concentration on such an argument supports the petition, and underscores the importance of correcting the erroneous decision of the Ninth Circuit.

The basis for the Ninth Circuit's reversal of the District Court's holding that both patents were in-

valid on the ground of anticipation, was its determination that both patented devices use a so-called "screwing action"*, and the devices shown in the prior art patents disclose only a "camming action".

In trying to identify what structural differences between the patented and prior art devices would lead to these supposedly different performances, the court of appeals correctly recognized that the only possible difference must be in the construction of the alleged "sharp edge" of the patented devices—the edge intended for engaging the end of an oncoming log. This edge is what the court referred to as "the heart of the self-opening mechanism in issue . . . on which appellant [respondent] relies as imparting novelty." (Pet. App., p. A-3). And, with respect to this edge, the court went on to say:

> "However, at this critical point of novelty the claims of the patents revert to descriptions in terms of function." (Pet. App., pp. A-3-4).

The court then went on to hold that this fatal defect, under *General Electric Co.* v. *Wabash Appliance Corp.*, 304 U.S. 364 (1938), had been cured by the third paragraph of 35 U.S.C. § 112. This means that the second paragraph of § 112, which has been substantially the same for more than one hundred years,

---

* That determination was obviously wrong because none of the Leffler claims mentions anything about "screwing action". Even if we assume that some of the claims mention "screwing action", and that such functional language could support patentability, the Leffler claims are still invalid in view of the earlier disclosure of the same invention in claim 12 of the Andersson patent which specifically refers to "screwing action".

should be disregarded in view of the third paragraph that was added in 1952.

Even if the court could disregard the second paragraph of § 112 in favor of the third paragraph, the claims here in issue must still fall. The specifications of the patents are just as vague and indefinite as are the claims. They provide us with no objective standard for determining when the log-engaging edge of a tool is "sharp" so as to be distinguishable from prior art tool edges. There is simply no structural definition of the term "sharp" anywhere in the patents. A reading of those portions of the patents quoted in footnotes 2 and 3 of the Ninth Circuit's opinion confirms the indefiniteness of the word "sharp" as used by the patentees (Pet. App., pp. A-4-6).

The public has no way of determining what the limits of the alleged inventions are, so that someone who wishes to avoid these patents will know how to build debarker tools without "sharp" log-engaging edges.

Respondent's admission (Resp. Br., p. 6) that the Ninth Circuit incorrectly applied the *Wabash* case supports the petition. The fact that in 1961, in *Locklin* v. *Switzer Brothers, Inc.*, 299 F.2d 160 (9 Cir., 1961), that court may have correctly understood *Wabash*, does not remedy the erroneousness of, or the confusion caused by, the present decision of the Ninth Circuit.

Respondent's brief does not, because it cannot, refute the argument that there is a direct conflict be-

tween the decision below of the Ninth Circuit and those of this Court in *Wabash* and *United Carbon Co.* v. *Binney & Smith Co.*, 317 U.S. 228 (1942). With respect to the Second, Seventh and Eighth Circuit decisions referred to in the petition, it is clear that in those circuits a combination-type claim, which uses functional language at the alleged point of novelty, would be invalidated. Respondent's attempts to distinguish these cases on their facts is beside the point.

On pages 2-4 of respondent's brief, references are made to a number of cases in various circuits, and particularly to the discussion of functional claims by the Court of Customs and Patent Appeals in *Application of Swinehart*, 439 F.2d 210 (C.C.P.A., 1971). That decision is far less pertinent than *Application of Hammack*, 427 F.2d 1378 (C.C.P.A., 1970). In *Hammack* the court specifically dealt with the requirements of the second paragraph of § 112, which requirements are precisely those that are here in issue. The court had the following to say (427 F.2d at 1382):

> "All provisions of the statute must be complied with in order to obtain a patent. The requirement stated in the second paragraph of section 112 existed long before the present statute came into force. Its purpose is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. Compare United Carbon Co. v. Bin-

ney & Smith Co., 317 U.S. 228, 63 S. Ct. 165, 87 L. Ed. 232 (1942), Kaiser Industries Corp. v. McLouth Steel Corp., 400 F.2d 36 (6th Cir. 1968)."

The petition for a writ of certiorari should be granted.

Respectfully submitted,

J. PIERRE KOLISCH
JON M. DICKINSON
Attorneys for Petitioners

KOLISCH, HARTWELL & DICKINSON
Of Counsel